

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Claudio L.K. Lins

Art Unit: 1797

Application No.: 09/766,730

Examiner: Monzer R. Chorbaji

Filed: January 22, 2001

For: ELECTROSTATIC DISINFECTANT
DELIVERY

APPELLANT'S REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer dated June 26, 2008, Appellant now submits his Reply Brief.

Status of Claims

Claims 1-27 are currently pending in this application. Claims 1-5, 9-15, 17 and 26-27 stand rejected, are being appealed and are at issue herein. Claims 6-8, 16, 18-25 stand allowed and are not at issue herein.

Grounds of Rejection to be Reviewed on Appeal

1. Whether claims 1-5, 9, 11-13, 15 and 17 are anticipated and unpatentable over U.S. Patent No. 6,531,142 to Rabe et al. (hereinafter "Rabe").

2. Whether claims 10 and 14 are obvious and unpatentable under 35 U.S.C. § 102(a) over the asserted combination of Rabe in view of U.S. Patent No. 5,591,395 to Schroeder et al. (hereinafter "Schroeder").

3. Whether claims 26-27 are obvious and unpatentable over the asserted combination of Rabe in view of U.S. Pat. No. 5,382,410 to Peltier.

Argument

I. Response to Examiner's Updated Comments

The Appellant respectfully maintains all applicable arguments with regard to the claims that currently stand rejected, namely claims 1-5, 9-15, 17 and 26-27, and hereby incorporates those arguments presented in the previous Appeal Brief dated December 14, 2006. The Appellant maintains that the primary issue on appeal remains the Examiner's erroneous factual determinations regarding what is disclosed in the primary reference Rabe, and namely that Rabe fails to disclose any compositions that are free of particulate material. In this Reply Brief, the Appellant focuses on those new issues or grounds of support presented by the Examiner in the Examiner's Answer and the Examiner's interpretation of the Rabe reference and the Appellant's Appeal Brief.

A. Examiner's Answer Section 10(I)(A) relating to the Anticipation rejections of claims 1-5, 9 and 11-12 under 35 U.S.C. § 102 over Rabe

Beyond the erroneous factual determinations outlined in the Appellant's Appeal Brief, the Examiner has set forth further factual errors in the Examiner's Answer that the Appellant will now address.

In the Examiner's response to the Appellant's Argument beginning on page 8 of the Examiner's Answer, the Examiner's own answer makes clear that an anticipation for claims 1-5, which require "wherein all composition components of the disinfectant composition for electrostatic dispensing are at least one of soluble and miscible," and claims 9, and 11-12 which require a disinfectant composition "wherein the electrostatically dispensable disinfectant composition is free of immiscible and insoluble topical composition particulates," cannot stand.

The Examiner again maintains that any combination of the components disclosed by Rabe is disclosed by relying on the boiler plate statements of Rabe. The Examiner gives an example of a possible composition disclosed by Rabe. Namely the Examiner states, "in one possible embodiment, the composition is only made up of one component, an insulating material, or in another embodiment, the composition is only made up of two components, insulating and conductive material, etc." However, this is not from the disclosure and not a quote from Rabe. There is not a single example in Rabe of any example according to the

Examiner's reasoning. In stead, the contrary is true as particulates (e.g. pigments) are necessary in Rabe to be a cosmetic product, which is the subject matter of Rabe.

Additionally, the Examiner misconstrues the disclosure of Rabe in an attempt to support this example when the Examiner states that "Rabe's composition is still sprayable without having the conductive material component, since it is presence is to enhance the electrical potential during spraying as taught by Rabe in Col. 6, Lines 6-9."

However, the Examiner's example and the Examiner's readings of Rabe, Col. 6, Lines 6-9 are entirely contradictory to the section of Rabe relied upon by the Examiner, which makes clear that at least a sufficient amount of conductive material is necessary for the composition to be sprayable. Rabe makes clear that, while the relative amount may vary, all compositions require "a sufficient amount of conductive material." Thus, no composition it discloses can merely be an "insulating material" as purported by the Examiner. More particularly, Rabe states:

The relative total levels of the insulating and conductive materials may vary, **provided that sufficient conductive material is present** that the composition realizes the electrical potential during spraying. The composition preferably comprises a total of from about 5% to about 85%...of conductive material.

The Appellant cannot see how any reasonable consistent reading of Rabe can be taken that Rabe merely discloses a composition that is free of conductive material, i.e. one that "is only made up of one component, an insulating material," as suggested by the Examiner. The presence of the conductive material is not merely "to enhance the electrical potential during spraying," as stated by the Examiner, but is a necessary component of all compositions as stated by Rabe. Thus, it follows that Rabe does not disclose or teach "any compositions" that are made of any combination of the listed components of Rabe, as suggested by the Examiner and the Examiner's Example. It further follows that Rabe does not then disclose any compositions that do not include the four primary components: (a) Liquid Insulating Material; (b) Conductive Material; (c) Powder Component; and (d) Thickening Agents.

Further, in clarifying the Examiner's position with regard to why the Examiner previously relied on the recitation of particulate material in the Optional Components category of Rabe in the Advisory Action, the Examiner apparently indicates that particulate material is no longer optional in Rabe compositions. As particulate material is not optional in the compositions disclosed by Rabe, Rabe cannot anticipate compositions that are

"soluble and miscible" or "free of immiscible and insoluble topical composition particulates."

Prior to this Appeal in the Advisory Action and in the Examiner's Answer, the Examiner pointed to the fact that because particulate material was found in the Optional Components category, this listing in the optional category effectively preempted, for at least one composition, the requirement of element (c), namely Powder Components¹ from the composition disclosed by Rabe. As outlined in the Appeal Brief, the inclusion of particulate material in the Optional Components category does not mean that element (c) Powder Components is optional in any compositions disclosed by Rabe.

Quite confusingly, the Examiner has now, in his Answer, apparently restated and then retracted this analysis regarding the optional, or unnecessary, position regarding particulate material. The Examiner states that:

In the advisory, the examiner pointed to the fact that particulates material are included under the 'optional components' list to show that particulate component is considered optional in one of the possible combinations of components as shown above in Rabe. However, **this teaching² does not mean that particulate material is optional** as Appellant concludes³. See Examiner's Answer Pg. 9, lines 4-8.

If Rabe has made clear that element (c) Powder Components are essential and the teaching of particulate material in the "Optional Components" category does not make particulate material optional, as indicated the Examiner and maintained by the Appellant, then particulate material is required and must be present in all compositions disclosed by Rabe.

If particulate material is required by all compositions of Rabe, then Rabe cannot meet the strict requirement of anticipation that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP 2131. Namely, Rabe does not disclose compositions "wherein all composition components of the disinfectant composition

¹ Powder Components are expressly indicated as particulates

² The teaching that Rabe teaches particulate matter may additionally found in the Optional Components category as well as one of the required elements, (c) Powder Components)

³ This statement that the Appellant has ever indicated that particulate material is option is absolutely false. The Appellant has always taken the position that particulate material is NOT optional in ANY composition taught by Rabe. The Appellant has always maintained that all embodiments of compositions taught by Rabe must include, at a minimum, four essential elements: (a) Liquid Insulating Material; (b) Conductive Material; (c) Powder Component; and (d) Thickening Agents. Element (c), being particulate material that is immiscible and insoluble in the composition as fully supported in the Appellant's Appeal Brief and identified in Rabe, for example, at Col. 3, Lines 29-30.

for electrostatic dispensing are at least one of soluble and miscible," (claims 1-5) or compositions "wherein the electrostatically dispensable disinfectant composition is free of immiscible and insoluble topical composition particulates" (claims 9, and 11-12).

Thus, the Examiner's Answer provides no additional support for how Rabe is an anticipatory reference that discloses compositions that are claimed in claims 1-5 and claims 9 and 11-12. As such, the Board is once again requested to overturn the rejection of claims 1-5, 9 and 11-12.

B. Examiner's Answer Sections 10(II)(A) - (C) relating to the Obviousness rejections of claims 10 and 14 under 35 U.S.C. § 103 over Rabe in view of Schroeder

As a preliminary matter, the obviousness rejections fail because of the improper factual reading of Rabe, and therefore the obviousness rejections fail to satisfy all limitations.

Moreover and further improper, the Examiner states that "Rabe composition is not limited to cosmetic applications, but further includes prophylactic applications, i.e. prevention against disease" and cites to Rabe, Col. 3, Lines 14-15. The Examiner relies on this "prophylactic application" as providing a reason as to why it would be obvious to modify the "topical compositions" that are to be applied to the skin into aerosols that are intended to remain within the air to reduce "airborne microbial" in view of the teachings of disinfecting air taught by Schroeder.

While the components of Rabe may be selected to provide prophylactic applications, the Examiner fails to address the fact that these compositions must still be "topical compositions" and the methods for applying these compositions are methods of treating or applying the compositions to the skin. See for example, Rabe at Col. 1, Lines 14-15; Col. 2, Lines 10-11; Col. 2, Lines 14-15; Col. 2, Lines 30-33; Col. 2, Lines 36-44; Col. 3, Lines 24-25. The Examiner indicates that it would be obvious to modify these "topical compositions" that may provide prophylactic applications to or for the skin that are configured to be deposited onto the skin so that such prophylactic applications can occur to a composition that is designed to remain in the air such that "airborne microbial" can be reduced.

Clearly, such a proposed modification of converting the compositions of Rabe that are configured to be deposited onto a surface, specifically the skin, into compositions that are configured to remain in the air to reduce "airborne microbial" would render the compositions of Rabe, the primary reference, unsatisfactory for its intended purpose. Similarly, converting any of the methods of dispensing such topical compositions such that they are disposed onto a surface into an aerosol that is to remain in the air to reduce airborne microbial would render

the dispensing methods of Rabe, the primary reference, unsatisfactory for its intended purpose. As such, the proposed combination is not obvious for this further reason as indicated by MPEP 2143.

Therefore, the fact that the Rabe compositions may be dispensed for some "prophylactic application," it would not be obvious to modify the Rabe compositions or methods of dispensing the compositions for any prophylactic application, but only for prophylactic application to a surface, and namely the skin.

Thus, the Board is respectfully solicited to overturn the rejections of and indicate the allowability of claims 10 and 14 for the reasons outlined in the Appeal Brief, the Reply Brief or the combination thereof.

C. Examiner's Answer Sections 10(II)(D) relating to the Obviousness rejections of claim 26 under 35 U.S.C. § 103 over Rabe in view of Peltier

Claim 26 requires supporting a dispensing apparatus within an air duct of a central air handling system. Again, the Examiner relies on Rabe's prophylactic application for providing a reason to modify the dispensing apparatus of Rabe into the claimed device. Again, modifying the dispensing apparatus of Rabe such that it is supported within an air duct of a central air handling system will render Rabe unsatisfactory for its intended purpose of dispensing topical compositions onto skin.

The explicit purpose of the device of Rabe is to be able to electrostatically spray the composition onto a particular surface, the skin of a person. By modifying the device of Rabe, such that it can no-longer spray the composition onto the skin of a person, but it vaporizes and/or forms an aerosol composition within an air duct, the modification significantly renders Rabe unsatisfactory for its intended purpose of applying the skincare or cosmetic composition to the skin of a person. As such, there is no reason to make the proposed modification of Rabe. See MPEP §2143.

Therefore, the Appellant respectfully solicits the Board to overturn the obviousness rejection of claim 26 and indicate the allowability thereof.

D. Conclusion

For the foregoing reasons, as well as the reasons previously set out in the Appellant's Appeal Brief, the Appellant respectfully requests that each of the anticipation and obviousness rejections that are maintained in the Examiner's Answer dated June 26, 2008 be

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reversed and withdrawn indicating allowance of the pending claims and that the Application move forward to issuance.

Respectfully submitted,

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